

## REMARKS

This responds to the Final Office Action dated February 20, 2009.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-16 remain pending in this application.

### Amendment to the Title

The title has been amended to more accurately reflect the claimed subject matter.

### §103 Rejection of the Claims

Claims 1, 2, 4 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Slezak in view of Bacon, Morrison and Pudar. It is noted that the Examiner failed to provide any explanation of the rejection of claims 2 and 6 under this ground of rejection, and that the Examiner's explanation of this ground of rejection included claim 5, which was not included in the list of rejected claims. Applicants will assume the Examiner intended to reject claims 1, 4, and 5 under this ground of rejection and respond accordingly.

For at least the reasons set forth below, Applicants respectfully submit this rejection is improper, and the identified claims are non-obvious over Slezak in view of Bacon, Morrison, and Pudar, and are therefore in condition for allowance.

Pursuant to 35 U.S.C. §103(a), "[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence.<sup>1</sup> The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness.<sup>2</sup> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.<sup>3</sup> "Mere identification in the prior art of each element is insufficient to

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<sup>1</sup> *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005)

<sup>2</sup> *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)

<sup>3</sup> M.P.E.P. §2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974))

defeat the patentability of the combined subject matter as a whole.”<sup>4</sup> Such a teaching or suggestion must be supported by substantial evidence.<sup>5</sup> Substantial evidence is something more than a mere scintilla of evidence.<sup>6</sup> “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”<sup>7</sup>

Independent claim 1 reads in pertinent part, as follows:

A method of presenting advertising in a subscriber broadcast system, the method comprising:

...  
receiving a plurality of video feeds including a plurality of advertisements.  
(Emphasis added throughout.)

Applicants respectfully submit that the cited references, individually or as part of any combination, do not teach or suggest the above-quoted limitations. Specifically, Slezak at Fig. 4, col. 5, lines 11-16 and 42-54, and col. 11, lines 52-62, cited by the Final Office Action as teaching the above limitations, does not teach or suggest the limitations. In the method of claim 1, video feeds are received in the subscriber broadcast system.

In stark contrast to the method of claim 1, the cited passages in Slezak merely describe video programming streams being delivered to the subscriber. Slezak specifically describes:

The head end 510 is connected to the Internet 530. Also connected to the Internet are a series of video servers 520a-520c. Each video server 520, discussed hereinafter, contains a content and subscriber database 522 and a programming database 524. The programming database 524 stores the primary and secondary programming.<sup>8</sup>

Thereafter, the Web server 540 directs the appropriate video server 520 to begin delivery of the primary program. The appropriate video server 520 can be selected based upon geographic location, the location of the subscriber's information, or even the location of the programming material. Thereafter, the video server 520 delivers the primary and secondary program material to the cable router 514 and the head end 510 via the Internet 510. The cable router 514 routes the program

<sup>4</sup> *In re Kahn*, 2006 WL 708687, page 9 (Fed. Cir. 2006)

<sup>5</sup> *Id.* at page 8.

<sup>6</sup> *Id.*

<sup>7</sup> *Id.* at page 10 (quoted in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007))

<sup>8</sup> Slezak, col. 5, lines 11-16

material to the appropriate subscriber's house 500. As the set-top unit 504 provides a two way communication route with the video server 520, an interactive viewing session can be carried out, as discussed hereinafter.<sup>9</sup>

As shown and described above, the preferred embodiments of the present invention enable an individualized video programming stream to be transmitted to a subscriber's house. The individualized video programming stream comprises a primary program, preferably formed of a primary video stream and a plurality of interleaved secondary programs, preferably formed of secondary video streams. The secondary video programs are interleaved, based upon input received from the viewer, subject matter being displayed in the primary material, and/or demographic and personal data regarding the subscriber stored in a database.<sup>10</sup>

It is evident from the above-quoted passages that programming material/video programming stream are delivered by the video server to a subscriber house via a head end and a cable router. However, the passages do not describe *receiving a plurality of video feeds including a plurality of advertisements in the subscriber broadcast system*, as recited in claim 1.

Also, FIG. 4 in Slezak merely shows an interactive advertising system that connects a number of application processing units (APPs) via a digital switching system (DSS) to set-top box units that facilitate interaction between the APPs and the subscriber via TVs. FIG. 4 does not relate to *receiving a plurality of video feeds including a plurality of advertisements in the subscriber broadcast system.* Accordingly, Slezak does not disclose the limitation of “*... in the subscriber broadcast system . . . receiving a plurality of video feeds including a plurality of advertisements,*” as recited in independent claim 1.

The Final Office Action did not use Bacon, Morrison or Pudar to show the above-discussed limitation, and Applicants could not find a passage in these references that teaches or suggests the limitation that is missing from Slezak.

Accordingly, Slezak, Bacon, Morrison, or Pudar, separately or as part of any combination, fail to teach or suggest each and every element of the independent claim 1. Therefore, Applicants respectfully submit that there are substantial differences between what is claimed and what is shown in Slezak, Bacon, Morrison and Pudar, whether they are considered separately or as part of any combination. Because the cited documents do not show all of the elements of the claimed subject matter of the amended independent claim 1, those differences are

<sup>9</sup> *Id.*, col. 5, lines 42-54

<sup>10</sup> *Id.*, col. 11, line 52-62

significant and non-obvious to a person of ordinary skill in the art at the time the application was filed. Furthermore, nothing in the disclosures of Slezak, Bacon, Morrison, or Pudar provides a reason for a person of ordinary skill in the art to seek to combine Slezak, Bacon, Morrison, or Pudar in the manner suggested by the Examiner. Accordingly, independent claim 1 and its dependent claims 4 and 5 are not rendered obvious by the proposed combination in the Final Office Action and thus are asserted to be in condition for allowance.

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Slezak in view of Bacon, Morrison, Pudar and Jeannin.

Claim 2 is dependent on claim 1 and is deemed to include every limitation of claim 1. As such, at least for the same reasons articulated above with respect to claim 1, claim 2 is not rendered obvious by the combination of Slezak, Bacon, Morrison, Pudar, and Jeannin. Jeannin fails to supply the above-quoted limitation of claim 1 that is missing in the other four references. It is noted that any claim depending from a non-obvious independent claim is also non-obvious. *See M.P.E.P. 2143.03.* As such, at least for the reasons noted above, claim 2 is not rendered obvious by the combination of Slezak, Morrison, Bacon, Pudar, and Jeannin and is in condition for allowance.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Slezak in view of Bacon, Morrison, Pudar and Eldering.

Claim 3 is dependent on claim 1 and, thus, is deemed to include every limitation of claim 1. As such, at least for the same reasons noted above with respect to claim 1, claim 3 is not rendered obvious by the combination of Slezak, Bacon, Morrison, Pudar, and Eldering. Eldering fails to supply the above-quoted limitation of claim 1 that is missing in the other four references. It is noted that any claim depending from a non-obvious independent claim is also non-obvious. *See M.P.E.P. 2143.03.* As such, at least for the reasons noted above, claim 3 is not rendered obvious by the combination of Slezak, Bacon, Morrison, Pudar, and Eldering and, thus, is in condition for allowance.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Slezak in view of Morrison, Pudar and Jeannin. Similar arguments as presented with respect to claim 1 are also applicable to a consideration of claim 6. Morrison, Pudar and Jeannin fail to supply the above-quoted limitation of claim 1 that is missing from Slezak.

Thus, at least for the same reasons articulated above with respect to claim 1, claim 6 is not rendered obvious by the combination of Slezak, Morrison, Pudar and Jeannin, and it is asserted to be in condition for allowance.

Independent claims 7 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Slezak in view of Emura, Dudkiewicz, and Pudar.

Similar arguments as presented with respect to claim 1 are also applicable to a consideration of claims 7 and 14. Emura, Dudkiewicz and Pudar fail to supply the above-quoted limitation of claim 1 that is missing from Slezak.

As further indicated in independent claims 7 and 14, the received video feeds are edited (e.g., “create, modify, and delete”) and formatted (“format said program content”, claim 7; “formatting said edited video feed”, claim 14) along with advertising content and transmitted to set-top boxes. These limitations are not shown in any of Slezak, Emura, Dudkiewicz or Pudar.

As such, at least for the reasons set forth above, independent claims 7 and 14 are not rendered obvious by the combination of Slezak, Emura, Dudkiewicz, and Pudar, and thus they are in condition for allowance.

Claims 8, 9, 12, 13 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak in view of Morrison, Emura, and Pudar.

Independent claim 8 recites, in pertinent part, as follows:

first computer program code operating on said processor to compare the first category indicator and the second category indicator to a stored category value and to compare the first priority level indicator with the second priority level indicator and to select said second advertisement when the second category indicator corresponds to said stored category value and the second priority level indicator is greater than or equal to said first priority level indicator. (emphasis added)

The Final Office Action, at page 15, when discussing the above limitation cites FIG. 5, col. 3, lines 16-55 and col. 5-6, lines 67-5 of Morrison, as teaching the above limitation.

Applicants respectfully submit that Morrison in FIG. 5 and the cited passages do not teach or suggest the limitation. FIG. 5 relates to program break flags and identifying places in the program where the break is to be inserted. Morrison in the cited passages describes that the receivers “contain a memory to store in real time the program materials subscribed to.”<sup>11</sup> “Message materials including announcements and commercials . . . are delivered to receivers separately and are stored in respective location in the receiver memory.”<sup>12</sup> “The receiver compares this message code data with the previously mentioned program break flags stored in the receiver.”<sup>13</sup> “The information is categorized, stored, and accessed as a conventional hierachal database stored in memory . . . User interface 40 drives a hierarchy of menus to allow a user to access the information by indicating the desired selections from the menus.”<sup>14</sup> However, the cited passages are silent with respect to the above-quoted limitation in claim 8.

Accordingly, Morrison, separately or as part of any combination, fails to teach or suggest what Slezak admittedly fails to teach. The Final Office Action did not use Emura or Pudar to show the above-discussed limitation, and Applicants could not find a passage in these references that teaches or suggests the limitation that is missing from Slezak and Morrison. As such, Morrison, Slezak, Emura, or Pudar, individually or in combination fail to teach each and every limitation of claim 8. Thus, claim 8 and its dependent claims 9, 12, and 13 are not rendered obvious by the combination and are in condition for allowance.

Similar arguments as presented with respect to claim 8 are also applicable to a consideration of independent claim 15. Thus, at least for the reasons set forth above with respect to claim 8, independent claim 15 is not rendered obvious by the combination of Slezak, Morrison, Emura, and Pudar, and thus it is in condition for allowance.

Claims 10, 11 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak in view of Morrison, Emura, Pudar, and Wachob.

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<sup>11</sup> Morisson, col. 3, lines 18-20

<sup>12</sup> *Id.*, lines 28-32

<sup>13</sup> *Id.*, lines 48-50

<sup>14</sup> *Id.*, col. 5, line 68 through col. 6, line 5

Claims 10 and 11 are dependent on claim 8, and claim 16 is dependent on claim 1, so they are thus deemed to include the same limitations as these claims. Therefore, at least for the same reasons articulated above with respect to claims 1 and 8, claims 10, 11, and 16 are not rendered obvious by the combination of Slezak, Morrison, Emura, Pudar, and Wachob. Wachob fails to supply the above-quoted limitations of claims 1 and 8 that are missing in the other four references. It is noted that any claim depending from a non-obvious independent claim is also non-obvious. *See M.P.E.P. 2143.03.* Accordingly, Slezak, Morrison, Emura, Pudar, and Wachob, individually or in combination, fail to teach or suggest each and every element of claims 10, 11 and 16. Thus, these claims are not rendered obvious by the combination and are in condition for allowance.

Applicants respectfully request that, in view of the arguments presented above, the claim rejections under 35 U.S.C. §103 (a) be reconsidered and withdrawn.

It is noted that the Final Office Action uses four or more references in the rejection of each grouping of claims. This is highly suggestive that the Examiner is using Applicants' structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicants' claimed subject matter. The Final Office Action merely selects a feature of the claim, states where it can be found in one of the references and then states it would be obvious to combine the references. In short, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components from *multiple references* in the manner contemplated and taught by the present applicants, without any indication that the combination is suggested by the references or by ordinary skill in the art and without citing any substantive reasoning for making the combination. This is a classic example of the use of hindsight reconstruction, and it cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has rejected such applications of hindsight by an examiner by specifically indicating that when an obviousness rejection is made based upon a combination of references, an examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the

manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added).

Merely indicating, as in the present Final Office Action, that the claimed invention would be obvious to one of ordinary skill in the art, based on the combination of *multiple references*, is inadequate.

Further, the use of individual elements from four or more references suggests that the Examiner is merely considering whether the *differences* are obvious, not whether the inventive subject matter as a whole is obvious.

### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (408) 278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 14, 2009.

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